

REMARKS/ARGUMENTS

Claims 11-13, 15, 17-19, 21, 22, and 24-26 are currently pending in the above-identified application. Claims 15, and 17-19 have been canceled without prejudice to Applicant's right to prosecute the subject matter of the claims in a co-pending application.

Rejections under 35 U.S.C. §112

The rejection of claims 1-13, 15, 20-21, and 23 under 35 U.S.C. §112, second paragraph, has been withdrawn by the Examiner as the claims have been canceled and/or amended. Further, the rejection of claims 1, 5, 6, 9-11, 13, 14, 17, and 20 under 35 U.S.C. §112, first paragraph, has been withdrawn by the Examiner as the claims have been canceled and/or applicants comments were considered persuasive.

Claims 15, and 17-19 remain rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner believes that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In particular, the Examiner does not believe that the unknown "candidate compound" meets the requirements of 35 U.S.C. §112, first paragraph. The Examiner believes that one must first conceive of the "candidate compound." Then one must, by preparing the compound himself, determine if the compound(s) works. The Examiner believes that the applicants can not regard as their invention inexact concepts the breadth of which they could not have possibly checked out with representative exemplification. Still further, the Examiner believes that since insufficient guidance and teaching have been provided by the specification, the skilled artisan, even with high level of skill, would be unable to use the instant assay as claimed without undue experimentation.

Claims 15, and 17-19 also stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The Examiner believes that the claims contain subject matter which was not described in the specification in such a way as to

reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the Examiner believes that the claimed method encompasses unidentified compounds, and as yet unidentified compounds a description of which is not found in the specification. Further, the Examiner does not believe that there is description of the "candidate compound" in the specification.

Applicants disagree with the rejections of the Examiner and question how claims to a method for screening compounds can also define and test all possible candidate compounds in order to meet the written description and enablement requirements as set forth. The requirements under 35 U.S.C. § 112, first paragraph, are not as set forth by the Examiner. Applicants, without acquiescing to any rejection or comment of the Examiner, cancel claims 15 and 17 - 19 without prejudice to Applicants' right to prosecute subject matter encompassed by the claims in a related co-pending application. With cancellation of claims 15 and 17 - 19 the rejections of the Examiner of the claims is moot.

Applicants acknowledge the indication of allowability for claims 11-13, 21, 22, and 24-26.

Appl. No. 10/069,431
Amdt. dated June 28, 2006
Reply to Office Action of April 6, 2006

PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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